

REMARKS

I. Introduction

Claims 8-19 are pending after addition of new claims 16-19. Claims 8-15 have been rejected. Claims 8 and 15 have been amended to correct typographical errors. Applicants respectfully request reconsideration of the application in view of the above amendments and the following explanations.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement (IDS), 1449 paper, and cited references. Applicants also appreciate the acknowledgement of the claim to foreign priority.

II. Rejection of Claims 8, 10, 11, 14 and 15 under 35 U.S.C. § 102(b)

Claims 8, 10, 11, 14 and 15 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,721,430 ("Wong").

As regards the anticipation rejection of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flow from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Regarding the Examiner's assertions with respect to the teachings of Wong as applied against the rejected claim 1, Applicants note that the teachings of Wong are fundamentally different from the Applicants' claimed invention. While Wong does disclose a

hermetically sealed housing, Wong clearly does not teach or suggest that the first chip and the second chip are connected to one another in a hermetically sealed fashion, as recited in claim 8. Wong describes a set of filters mounted on a filter mount, which is attached to a housing base on which infrared detectors are located (col. 16, lines 25-56). Rather than being hermetically attached, the filter mount is merely positioned over the housing base while a top lid is attached to the housing base to form a complete housing (col. 17, lines 4-20). The filter mount and the housing base are not hermetically sealed to each other in any way. Accordingly, amended claim 8 and its dependent claims 10, 11 and 14 are not anticipated by Wong.

Claim 15 recites subject matter analogous to that of claim 8. Accordingly, claim 15 is allowable for at least the same reasons.

In view of all of the foregoing, withdrawal of the anticipation rejection is respectfully requested.

III. Rejection of Claims 9 and 13 under 35 U.S.C. § 103(a)

Claims 9 and 13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As discussed above, Wong does not identically disclose or suggest the limitations of claim 8. Claims 9 and 13 depend from claim 8 and are therefore allowable for at least the same reasons.

IV. Rejection of Claim 12 under 35 U.S.C. § 103(a)

Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong in view of U.S. Patent No. 5,892,140 (“Wood”).

Claim 12 depends on claim 8. Furthermore, the teachings of Wood simply do not remedy the deficiencies of Wong as applied against parent claim 8, i.e., Wood similarly fails to teach or suggest that the first chip and the second chip are connected to one another in a hermetically sealed fashion, as recited in claim 8. For at least this reason, dependent claim 12 is not rendered obvious by the combination of Wong and Wood.

V. New Claims 16-19

New claims 16-17 and 18-19 depend on independent claim 8 or 15, and therefore new claims 16-17 and 18-19 are allowable for at least the same reasons as their parent claims.

CONCLUSION

For at least the foregoing reasons, it is respectfully submitted that all pending claims of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully Submitted,

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